

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Michel Kubacki
Title: METHODS, RACK AND
DEVICE FOR PREPARING
SAMPLES FOR ANALYSIS
Appl. No.: 10/544,158
International Filing Date: 2/2/2004
371(c) Date: 10/14/2005
Examiner: Timothy Lewis Maust
Art Unit: 3751
Confirmation Number: 8425

REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT
UNDER 37 C.F.R. §1.705

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants are in receipt of the Notice of Allowance for the above-referenced application. Applicants disagree with the Determination of Patent Term Adjustment (PTA) under 35 U.S.C. § 154(b) and present the following facts per procedure set forth in 37 C.F.R. § 1.705(d) to support their contention that the patent term adjustment should be 1048 days instead of 656 days as calculated by the United States Patent and Trademark Office (USPTO).

The Patent Office determined that the patent was entitled to 656 days of PTA. Applicants believe that this PTA determination was made in accordance with the “Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. §154(b)(2)(A)” published at 69 Fed. Reg. 34238 (Jun. 21, 2004). Under that interpretation of the PTA statute, any PTO delay under 35 U.S.C. § 154(b)(1)(A) is deemed to overlap with any 3-year maximum pendency delay under 35 U.S.C. § 154(b)(1)(B), and so, as a practical effect, PTA may be awarded under §154(b)(1)(A) or §154(b)(1)(B), but not both.

On September 30, 2008, the United States District Court for the District of Columbia issued a decision finding that the U.S. Patent and Trademark Office’s interpretation of the PTA statute is incorrect. *Wyeth v. Dudas*, Civ. Action No. 07-1492 (JR) (Sep. 30, 2008).

The court determined that, under the correct interpretation of the PTA statute, periods of "overlap" are limited to "periods of time . . . [that] occur on the same day." *Wyeth*, slip op. at 8. Thus, a PTO delay under §154(b)(1)(A) overlaps with a delay under §154(b)(1)(B) only if the delays "occur on the same day." *Id.*

Applicants have recalculated PTA for the captioned patent under the court's interpretation of the PTA statute, and have determined that the patent is entitled to 1048 days PTA, as shown on the attached sheet, which shows the relevant delays under 37 CFR §§1.702(a) and (b), and under 37 CFR §§1.703(a) and (b).

There were no circumstances during the prosecution of the application resulting in the patent that constitute a failure to engage in reasonable efforts to conclude processing or examination of such application as set forth in § 1.704.

(a) Total of non-overlapping PTO delay under §154(b)(1)(A) & (B): 1048 days

(b) Total Applicant delay: 0 days

Final PTA Determination: 1048 days

Applicants therefore respectfully request that the patent be accorded 1048 days PTA.

The patent is not subject to a terminal disclaimer.

Payment of the requisite fee is submitted herewith. Should no proper payment be enclosed herewith, as by the credit card payment instructions in EFS-Web being incorrect or absent, resulting in a rejected or incorrect credit card transaction, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741.

However, because this PTA error is due to a Patent Office error in interpreting and applying the PTA statute, a refund of the fee is respectfully requested.

Applicants request further that a decision on this request be **deferred or delayed** until a final decision has been rendered in *Wyeth v. Dudas*, which is now on appeal at the U.S. Court of Appeals for the Federal Circuit, under Federal Circuit Docket No. 2009-1120.

Respectfully submitted,

Date July 16, 2009

FOLEY & LARDNER LLP
Customer Number: 23524
Telephone: (608) 258-4263
Facsimile: (608) 258-4258

By



Callie M. Bell
Attorney for Applicant
Registration No. 54,989

CLOSE WINDOW

ALL CASES SELECT CASE

Patent Term Adjustment Calculation System

Add a new event to this case

Docket Number: 052546-0480

Application Number: 10/544158

Patent Number: N/A

	Event Description	Event Date	Days from Filing	PTO Days	Applicant Days
Edit Delete	Priority Date	02/03/2003	-912		
Edit Delete	International Filing Date	02/02/2004	-548		
	PCT National Stage Commencement Date	08/03/2005	0		
Edit Delete	National Stage Entry (All 371(c) Requirements Met)	10/14/2005	72		
	14 month From Application date	12/14/2006	498		
	3 Year Period Starts	08/03/2008	1,096		
Edit Delete	Restriction Requirement	09/30/2008	1,154	(656)	
Edit Delete	Restriction Requirement Response Received at PTO	10/30/2008	1,184		
Edit Delete	Non-Final Office Action	01/28/2009	1,274		
Edit Delete	Non-Final Office Action Rsp. Rcv'd at PTO	04/06/2009	1,342		
Edit Delete	Notice of Allowance	04/17/2009	1,353		
	Projected Patent Grant Date	10/27/2009	1,546	(450) 1048	
			Totals:	1,048	0
			PTA:	1,048	

Created and maintained by

FOLEY**FOLEY & LARDNER LLP**

Version: 3.02.05

LOGIN: Victoria Downing

IP: 10.24.5.12

Foley & Lardner LLP